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PTO/SB/64 (09-04)
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U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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**PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT
ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)**

Docket Number (Optional)
NAN012
Customer No. 25,201

First named inventor: John M. Callahan

Application No.: 09/642,858

Art Unit: 2133

Filed: August 21, 2000

Examiner: David Ton

Title: ROM ERROR CORRECTION CONTROL

Attention: Office of Petitions

Mail Stop Petition

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

FAX (703) 872-9306

NOTE: If information or assistance is needed in completing this form, please contact Petitions Information at (703) 305-9282.

The above-identified application became abandoned for failure to file a timely and proper reply to a notice or action by the United States Patent and Trademark Office. The date of abandonment is the day after the expiration date of the period set for reply in the office notice or action plus an extensions of time actually obtained.

APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION

NOTE: A grantable petition requires the following items:

- (1) Petition fee;
- (2) Reply and/or issue fee;
- (3) Terminal disclaimer with disclaimer fee - required for all utility and plant applications filed before June 8, 1995; and for all design applications; and
- (4) Statement that the entire delay was unintentional.

1. Petition fee

☒ Small entity-fee \$ 750.00 (37 CFR 1.17(m)). Applicant claims small entity status. See 37 CFR 1.27.

☐ Other than small entity - fee \$ _____ (37 CFR 1.17(m))

2. Reply and/or fee

A. The reply and/or fee to the above-noted Office action in the form of _____ (identify type of reply):

- ☐ has been filed previously on _____.
- ☐ is enclosed herewith.

B. The issue fee and publication fee (if applicable) of \$ _____.

- ☒ has been paid previously on October 1, 2003.
- ☒ is enclosed herewith. (Additional \$5.00 to cover increase in Issue Fee).

[Page 1 of 2]

This collection of information is required by 37 CFR 1.137(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1.0 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

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Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

3. Terminal disclaimer with disclaimer fee

- ☒ Since this utility/plant application was filed on or after June 8, 1995, no terminal disclaimer is required.
- ☐ A terminal disclaimer (and disclaimer fee (37 CFR 1.20(d)) of \$ _____ for a small entity or \$ _____ for other than a small entity) disclaiming the required period of time is enclosed herewith (see PTO/SB/63).

4. STATEMENT: The entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional. Pursuant to a Decision for a Petition previously submitted under 37 CFR 1.137 (a) mailed August 4, 2004 (copy enclosed), the present Petition under 37 CFR 1.137 (b) is filed. The Issue Fee was previously paid on October 1, 2003.

Patrick T. King

Signature

April 7, 2005

Date

Patrick T. King

28,231

Customer NO. 25, 201

Registration Number, if applicable

144 Holm Road, #39

(831) 722-8591

Address

Telephone Number

Watsonville, CA 95076-2427

Address

Enclosures: ☒ Fee Payment

☒ Reply (Previously Submitted)

☐ ~~Terminal Disclaimer Form~~ If any additional extensions and/or fee is required, charge Account No. 110979.

☐ Additional sheets containing statements establishing unintentional delay

☒ Other: Form PTO-2038 (Credit Card Information)

CERTIFICATE OF MAILING OR TRANSMISSION [37 CFR 1.8(a)]

I hereby certify that this correspondence is being:

☒ Deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Mail Stop Petition, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450.

☐ Transmitted by facsimile on the date shown below to the United States Patent and Trademark Office as (703) 872-9306.

April 7, 2005

Date

Patrick T. King

Signature

Patrick T. King

Typed or printed name of person signing certificate



DAE ✓

**Transmittal: Petition for Revival of an Application for Patent
Abandoned Unintentionally under 37 CFR 1.137(b)**

I hereby certify that this transmittal of the below described document is being deposited with the United States Postal Service in an envelope bearing First Class Postage and addressed to the Mail Stop Petition, Commissioner for Patents, P O Box 1450, Alexandria, VA 22313-1450, on the below date of deposit.				
Date of Deposit:	4/7/05	Name of Person Making the Deposit:	Patrick T. King	Signature of the Person Making the Deposit:

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): John M. Callahan

Docket No: NAN012
Customer No. 25, 201

Serial No.: 09/642,858

Group Art Unit: 2133

Filed: August 21, 2000

Examiner: David Ton

Title: ROM ERROR CORRECTION CONTROL

Mail Stop: Petition
Commissioner for Patents
P O Box 1450
Alexandria, VA 22313-1450

**Transmittal: Petition for Revival Of An Application For
Patent Abandoned Unintentionally (Under 37 CFR §1.37(b))**

1. Transmitted herewith is a Petition for the above identified Patent Application.
2. In an Office Communication mailed on August 4, 2004 for the above-identified U. S. Patent Application, Applicant received a Notice that the Petition for Revival of an Application for Patent Abandoned Unavoidable for alleged failure to timely pay the required Issue Fees was Dismissed.
3. In accordance with 37 CFR 1.137(b), Applicant hereby requests the Commissioner to accept the enclosed Petition to revive the above-identified Abandoned U. S. Patent Application for Patent Abandoned Unintentional.
4. Fee Payment: Please find an Original and one copy of the Credit Card Payment Form No. PTP-2038 to pay the sum of \$750.00 for this Petition plus an additional \$5.00 to cover the increase cost for an Issue fee.
5. Fee Deficiency: Please charge Deposit Account 110979 for any additional extension and/or fee that is required.

Reg. No. 28,231
Date: April 7, 2005

Phone (831) 722-8591
Fax (831) 722-8591

Patrick T. King
144 Holm Road #39
Watsonville, CA 95076-2427



UNITED STATES PATENT AND TRADEMARK OFFICE



COPY

Commissioner for Patents
United States Patent and Trademark Office
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Alexandria, VA 22313-1450
www.uspto.gov

Paper No. 16

PATRICK T. KING
LAW OFFICES OF PATRICK T. KING
144 HOLM ROAD #39
WATSONVILLE, CA 95076-2427

COPY MAILED

AUG 04 2004

OFFICE OF PETITIONS

In re Application of
John M. Callahan
Application No. 09/642,858
Filed: August 21, 2000
Attorney Docket No. NAN012

ON PETITION

This is a decision on the petition under 37 CFR 1.137(a), filed June 21, 2004, to revive the above-identified application.

The petition is **DISMISSED**.

Any request for reconsideration or petition under 37 CFR 1.137(b) must be submitted within TWO (2) MONTHS from the mail date of this decision. Extension of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.137(a)." This is **not** a final agency action within the meaning of 5 U.S.C § 704.

The above-identified application became abandoned for failure to reply to the "Notice of Allowance and Issue Fee Due" (the "Notice") mailed May 16, 2003, which set a statutory period for reply of three-month from its mailing date. No response was received within the allowable period, and the application became abandoned on August 17, 2003. A Notice of Abandonment was mailed on November 13, 2003.

A grantable petition under 37 CFR 1.137(a)¹ must be accompanied by: (1) the required reply,² unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(1); (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due

¹As amended effective December 1, 1997. See Changes to Patent Practice and Procedure; Final Rule Notice 62 Fed. Reg. 53131, 53194-95 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 119-20 (October 21, 1997).

² In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and (4) any terminal disclaimer required by 37 CFR 1.137(c).

The instant petition lacks item (3).

The Commissioner is responsible for determining the standard for unavoidable delay and for applying that standard.

"In the specialized field of patent law, . . . the Commissioner of Patent and Trademarks is primarily responsible for the application and enforcement of the various narrow and technical statutory and regulatory provisions. The Commissioner's interpretation of those provisions is entitled to considerable deference."³

"[T]he Commissioner's discretion cannot remain wholly uncontrolled, if the facts clearly demonstrate that the applicant's delay in prosecuting the application was unavoidable, and that the Commissioner's adverse determination lacked any basis in reason or common sense."⁴

"The court's review of a Commissioner's decision is 'limited, however, to a determination of whether the agency finding was arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with the law.'"⁵

"The scope of review under the arbitrary and capricious standard is narrow and a court is not to substitute its judgment for that of the agency."⁶

The standard

"[T]he question of whether an applicant's delay in prosecuting an application was unavoidable must be decided on a case-by-case basis, taking all of the facts and circumstances into account."⁷

³Rydeen v. Quigg, 748 F.Supp. 900, 904, 16 U.S.P.Q.2d (BNA) 1876 (D.D.C. 1990), aff'd without opinion (Rule 36), 937 F.2d 623 (Fed. Cir.1991) (citing Morganroth v. Quigg, 885 F.2d 843, 848, 12 U.S.P.Q.2d (BNA) 1125 (Fed. Cir. 1989); Ethicon, Inc. v. Quigg 849 F.2d 1422, 7 U.S.P.Q.2d (BNA) 1152 (Fed. Cir. 1988) ("an agency' interpretation of a statute it administers is entitled to deference"); see also Chevron U.S.A. Inc. v. Natural Resources Defence Council, Inc., 467 U.S. 837, 844, 81 L. Ed. 694, 104 S. Ct. 2778 (1984) ("if the statute is silent or ambiguous with respect to the specific issue, the question for the court is whether the agency's answer is based on a permissible construction of the statute.")

⁴Commissariat A L'Energie Atomique et al. v. Watson, 274 F.2d 594, 597, 124 U.S.P.Q. (BNA) 126 (D.C. Cir. 1960) (emphasis added).

⁵Haines v. Quigg, 673 F. Supp. 314, 316, 5 U.S.P.Q.2d (BNA) 1130 (N.D. Ind. 1987) (citing Camp v. Pitts, 411 U.S. 138, 93 S. Ct.1241, 1244 (1973) (citing 5 U.S.C. §706 (2)(A)); Beerly v. Dept. of Treasury, 768 F.2d 942, 945 (7th Cir. 1985); Smith v. Mossinghoff, 217 U.S. App. D.C. 27, 671 F.2d 533, 538 (D.C. Cir.1982)).

⁶Ray v. Lehman, 55 F.3d 606, 608, 34 U.S.P.Q.2d (BNA) 1786 (Fed. Cir. 1995) (citing Motor Vehicles Mfrs. Ass'n v. State Farm Mut. Auto. Ins. Co., 463 U.S. 29, 43, 77 L.Ed.2d 443, 103 S. Ct. 2856 (1983)).

⁷Id.

The general question asked by the Office is: "Did petitioner act as a reasonable and prudent person in relation to his most important business?"⁸ Nonawareness of a PTO rule will not constitute unavoidable delay.⁹

Application of the standard to the current facts and circumstances

In the instant petition, petitioner maintains that the circumstances leading to the abandonment of the application meet the aforementioned unavoidable standard and, therefore, petitioner qualifies for relief under 37 CFR 1.137(a). In support thereof, petitioner asserts that the Notice was mailed to an incorrect address, notwithstanding the request for change of correspondence address filed by petitioner prior to the mailing of the Notice.

With regard to item (3) above, the aforementioned argument of petitioner in support of petitioner's belief that the above-cited application was unavoidably abandoned is not persuasive. The reason petitioner's argument must necessarily fail are addressed below.

Petitioner's argument relative to the filing of the a request for change of correspondence address and the failure of the Patent and Trademark Office to acknowledge the same is noted and is persuasive, however; a successful petition under 37 CFR 1.137(a) requires that petitioner establish that the entire delay in filing a proper response to the last action was unavoidable—beginning from the due date for a reply to the filing of a grantable petition. Based on the facts presented, it appears that petitioner was aware of the problems with application from at least August 21, 2003, and received the Notice of Abandonment mailed November 13, 2003, yet the instant petition was not filed until June 21, 2004. Petitioner must, therefore, account for the seven-month delay in filing the instant petition in order to establish that the entire delay in filing a proper response to the Notice was unavoidable.

fee — Petitioner may wish to consider filing a petition to revive based on unintentional abandonment under 37 CFR 1.137(b). A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by the required reply (already submitted), the required petition fee (\$1,330.00 for a large entity and \$665.00 for a verified small entity), and a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional.

⁸See *In re Mattulah*, 38 App. D.C. 497 (D.C. Cir. 1912).

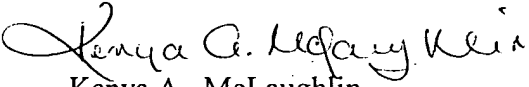
⁹See *Smith v. Mossinghoff*, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (Fed. Cir. 1982) (citing *Potter v. Dann*, 201 U.S.P.Q. (BNA) 574 (D.D.C. 1978) for the proposition that counsel's nonawareness of PTO rules does not constitute "unavoidable" delay)). Although court decisions have only addressed the issue of lack of knowledge of an attorney, there is no reason to expect a different result due to lack of knowledge on the part of a pro se (one who prosecutes on his own) applicant. It would be inequitable for a court to determine that a client who spends his hard earned money on an attorney who happens not to know a specific rule should be held to a higher standard than a pro se applicant who makes (or is forced to make) the decision to file the application without the assistance of counsel.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petitions
 Commissioner for Patents
 Box 1450
 Alexandria, VA 22313-1450

By facsimile: (703) 308-6916
 Attn: Office of Petitions

Telephone inquiries should be directed to the undersigned (703) 305-0010.


Kenya A. McLaughlin
Petitions Attorney
Office of Petitions